

Grants of Dalvey v. Dalvey & Co. LLC

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF RHODE ISLAND

GRANTS OF DALVEY LTD	:	
Plaintiff,	:	
v.	:	C.A. No 2023- _____
DALVEY & CO. LLC.	:	JURY TRIAL DEMANDED
Defendant.	:	

COMPLAINT FOR TRADEMARK INFRINGEMENT

Plaintiff Grants of Dalvey Ltd. brings this action against Defendant Dalvey & Co. for trademark infringement and ancillary State law claims as set forth more particularly herein. Plaintiff seeks, *inter alia*, injunctive relief and money damages and alleges as follows:

NATURE OF THIS ACTION

1. Plaintiff Grants of Dalvey Ltd. owns and uses in commerce throughout the United States registered trademarks DALVEY®. Defendant Dalvey & Co. LLC. is using in commerce throughout the United States the trademark DALVEY & CO. which is likely to cause confusion and infringe on Plaintiff's registered trademarks.

PARTIES, JURISDICTION AND VENUE

2. Plaintiff Grants of Dalvey Ltd. is a United Kingdom based private limited company with its principal place of business located at Alness, Ross-Shire, IV17 0XT, United Kingdom. Plaintiff is a world leader in manufacturing high-end, enduring pieces of exceptional design and quality for discerning customers around the world, including, but not limited to, compasses, pocket watches, flasks, clocks, barometers, cufflinks, card-holder-money-clips and clothing, for men. Its products are sold throughout the United States and Europe. Plaintiff maintains an online store with the url: <https://www.dalvey.com/us/> Exhibit A.

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3. Upon information and belief, Defendant Dalvey & Co. LLC. is a Pennsylvania corporation with its principal place of business at 48 Farrier Lane, Newtown Square, Pennsylvania 19073. Defendant makes custom themed gift boxes and curated care packages. Its products are sold throughout the United States.

4. Plaintiff Grants of Dalvey Ltd. has several registered trademarks that it has been using in commerce as early as 1996 under the title DALVY® as follows (hereinafter referred to as “the Marks”) Exhibit “B”:

MARK	Serial No./ Filing Date	Registration No./ Registration Date	Goods Claimed	Status
DALVEY	76/027,289 April 17, 2000	2,713,962 May 6, 2003	Clocks, and parts, fittings and cases therefor; Business card cases and credit card cases; Flasks[, and containers for holding flasks]	Renewed 4/26/2023
DALVEY	79/305,307 January 14, 2021	6,564,816 November 23, 2021	Compasses, namely, directional compasses and magnetic compasses; Watches, pocket watches	Pending
DALVEY	97/046,766 September 27, 2021	6,994,715 March 7, 2023	Cufflinks; key rings; pocket watches and pocket watch chains sold as a unit; wristwatches and cufflinks sold as a unit; cufflinks and pocket squares sold as a unit; Pencils; pens; money clips; letter openers; globes; blank paper notebooks for writing and sketching; blank journals for writing and sketching; money clips and cufflinks sold as a unit; Wallets; toiletry bags sold empty for carrying toiletries; wallets and cufflinks sold as a unit; Ties as clothing; pocket squares; belts; socks; scarves; gloves; shirts; pocket squares and cufflinks sold as a unit; multiple pairs of socks sold as a unit; multiple ties as clothing sold as a unit; online retail gift shops ; gift wrapping; delivery of	Pending

			goods, namely, gifts, greeting cards, and gift cards	
DALVEY	97/046,643 September 27, 2021	7,015,600 April 4, 2023	Shaving soap; Razors; Barometers; Sunglasses; Computer mice; Hourglasses; Bowls; Shaving brush stands; Shaving brushes; Valet trays for household purposes; Textile handkerchiefs; Dice	Pending

5. This Complaint alleges causes of action under the Trademark laws of the United States, Chapter 15 (The “Lanham Act”) of the United States Code, in particular, §43(a) of the Lanham Act, 15 U.S.C. §1125.

6. This Court has subject-matter jurisdiction over this Complaint pursuant to 28 U.S.C. §1338.

7. This Court has personal jurisdiction over Defendant pursuant to substantial and continuous contacts within the state of Rhode Island that all relate to and/or from the basis of this action and/or that they have done and continue to do business in this District, including but not limited to, offering a sale of goods throughout this District through websites, mobile websites, and other media.

8. This Court has long arm jurisdiction over the nonresident defendant pursuant to RIGL §9-5-33(a) as Defendant has made sales in the State of Rhode Island.

9. Venue is proper in this District pursuant to 28 U.S.C. §§ 1391 and 1400(b).

FACTUAL BACKGROUND

A. Ownership of the Trademark at Issue

10. DALVEY®, the trademarks at issue, has been used in commerce as early as June 1996. Grants of Dalvey Ltd. is the current owner of these priority trademarks.

11. The trademarks at issue designate International Classes 003, 008, 009, 014, 016, 018, 021, 024, 025, 028, 035 and 039. The goods and services covered by the Marks are listed in the above table in Paragraph 4 of this Complaint.

B. Trademark Infringement

12. Plaintiff Grants of Dalvey Ltd. uses its registered trademarks DALVEY® in the quality gifts and accessories industry, primarily for, but not exclusively for, men with discerning taste.

13. Defendant Dalvey & Co. uses the unregistered DALVEY & CO. mark to brand curated gift boxes containing a number of the goods protected by the trademarks listed in paragraph 4 above, including, but not limited to, men's clothing, key chains, bar tools, note pads, journals, soaps and toiletry bags, all of which infringe on one or more of the trademarks listed in paragraph 4 above. In addition, Defendant maintains an online store with the url: <https://www.dalveyandco.com>, a direct infringement of Plaintiff's U.S. Registration Trademark No. 6,994,715.

14. As evidenced by Exhibit "C", Defendant advertises and uses promotional material that misrepresents the nature, characteristics and qualities of its products sold under the DALVEY® trademark.

15. Defendant's misrepresentation in a commercial advertising or promotion was disseminated to potential and actual purchasers.

16. Defendant's misrepresentations were actually, and likely to influence, the purchasing decisions of the persons to whom it was disseminated.

17. Defendant's misrepresentations injured Plaintiff by causing Plaintiff to lose customers, sales and caused additional unnecessary business expenses resulting in business losses.

18. Defendant's misrepresentations were made in commerce.

19. Defendant's misrepresentations are likely to cause Plaintiff irreparable harm financially and by damaging Plaintiff's business reputation.

20. In addition, Defendant's product harms consumer perception of Plaintiff's unique products, otherwise known as "dilution by blurring and dilution by tarnishment," as defined in 15 U.S.C. §§1125(c)(2)(B) and (c)(2)(C), respectively.

**Claim for Relief
(15 U.S.C. §§ 1114 and 1125)
(Infringement of a Federally Registered Trademark)**

21. Plaintiff realleges and incorporates by reference Paragraphs 1 through 20 as if fully set forth here.

22. Plaintiff Grants of Dalvey Ltd. has federally registered trademarks on the United States Patent and Trademark Office's Principal Register for DALVEY®.

23. Defendant Dalvey & Co. is using the DALVEY® trademark without consent or permission .

24. Defendant had actual and constructive knowledge of the use in commerce and existence of the DALVEY® marks.

25. There is a likelihood of confusion between the DALVEY® marks and Defendant's DALVEY & CO. mark.

26. Plaintiff is known in the luxury item industry and has goodwill in the industry. Defendant is using Plaintiff's DELVEY® marks on its products, and consequently on its website, and in other marketing materials, without permission, to trade off the goodwill of Plaintiff.

27. Defendant is misappropriating the goodwill that Plaintiff has established for over 27 years by using the confusingly similar mark for related services. As a result, Defendant's use of the DALVEY® marks is infringing on Plaintiff's federally registered trademarks and is causing

injury to Plaintiff.

28. Defendant has committed such acts, and will continue to commit such acts, in an intentional and willful manner, that make this case exceptional under 15 U.S.C. §1117(a).

RELIEF REQUESTED

WHEREFORE, Plaintiff Grants of Dalvey Ltd. prays for judgment in its favor and against Defendant Dalvey & Co., and requests that:

29. Judgment be entered in favor of Plaintiff against Defendant on each count of this Complaint;

30. Defendant be adjudged to have infringed Plaintiff's federally registered trademarks and that such infringement be adjudged to have been exceptional;

31. Defendant be temporarily, preliminarily, and thereafter permanently enjoined and ordered to cease making, using, offering for sale or selling any goods or products that contain the DALVEY® mark, and to recall all offending materials;

32. Plaintiff be awarded compensation representing profits earned by Defendant through its misrepresentations in an amount no less than a reasonable royalty of Defendant's gross sales of any infringing products;

33. Plaintiff be awarded treble damages pursuant to 15 U.S.C. §1117(b) and 35 U.S.C. §284 because of the willful nature of Defendant's acts;

34. Plaintiff be awarded exemplary damages pursuant to RIGL §§ 6-41-3;

35. Plaintiff be awarded prejudgment interest;

36. Plaintiff be awarded its costs, attorneys' fees and expenses under 15 U.S.C. § 117(a), 35 U.S.C. § 285 and RIGL § 6-41-4;

37. Plaintiff be awarded compensation for Plaintiff's lost profits;

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38. Plaintiff be awarded compensation for expenses incurred by Plaintiff in counteracting the effects of Defendant's misrepresentations; and
39. Plaintiff be awarded such other and further relief as this Court may deem just and proper.

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JURY TRIAL DEMANDED ON ALL COUNTS THAT MAY BE SO TRIED

Dated: June 27, 2023

Grants of Dalvey Ltd.

By its attorneys,

/s/ Alan F. Feeney, Esq.

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